UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,098	01/23/2001	David P. Golds	2630	9628

7590	04/24/2006

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EXAMINER
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ART UNIT	PAPER NUMBER
2195	

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/768,098	GOLDS ET AL.
	Examiner	Art Unit	
	Lewis A. Bullock, Jr.	2195	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   Claims 21-23 and 25 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. The cited claims detail a tangible computer

readable medium. However, its unclear as to what this is considered to be. Amending

the claims from the "tangible computer-readable medium having computer-executable

instructions" to "computer storage medium storing computer-executable instructions"

would alleviate this issue.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 24 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. In order for a claimed process to be statutory

the claimed computer-related process must either A) result in a physical transformation

outside the computer for which a practical application I the technological arts is either

disclosed in the specification or would have been known to a skilled artisan or B) be

limited to a practical application within the technological arts and thereby producing a

useful, concrete, and tangible result. The relevant portions of Chapter 2100 is copied

below. M.P.E.P. 2106:

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan (discussed in i) below), or (B) be limited to a practical application within the technological arts (discussed in ii) below). See *Diamond v. Diehr*, 450 U.S. at 183-84, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1877)) ("A [statutory] process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.... The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence."). See also *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *id.* at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) ("unpatentability of the principle does not defeat patentability of its practical applications") (citing *O 'Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). If a physical transformation occurs outside the computer, a disclosure that permits a skilled artisan to practice the claimed invention, i.e., to put it to a practical use, is sufficient. On the other hand, it is necessary for the claimed invention taken as a whole to produce a practical application if there is only a transformation of signals or data inside a computer or if a process merely manipulates concepts or converts one set of numbers into another.

There is always some form of physical transformation within a computer because a computer acts on signals and transforms them during its operation and changes the state of its components during the execution of a process. Even though such a physical transformation occurs within a computer, such activity is not determinative of whether the process is statutory because such transformation alone does not distinguish a statutory computer process from a nonstatutory computer process. What is determinative is not how the computer performs the process, but what the computer does to achieve a practical application. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036.

A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is nonstatutory despite the fact that it might inherently have some usefulness. In *Sarkar*, 588 F.2d at 1335, 200 USPQ at 139, the court explained why this approach must be followed:

For such subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *Alappat* 33 F.3d at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) ("unpatentability of the principle does not defeat patentability of its practical applications") (citing *O 'Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See *AT &T*, 172 F.3d at 1358, 50 USPQ2d at 1452. Likewise, a machine claim is statutory when the machine, as claimed, produces a concrete, tangible and useful result (as in *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601) and/or when a specific machine is being claimed (as in *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557 (*> en< banc*). For example, a computer process that simply calculates a mathematical algorithm that models noise is nonstatutory. However, a claimed process for digitally filtering noise employing the mathematical algorithm is statutory.

Applicant claims as written detail assigning a numeric value to a software module and maintaining the association. The claims as written provide no concrete, useful, and tangible result.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

YOUNG (U.S. Patent 6,782,531)

As to claim 1, YOUNG teaches in a computer system, a method comprising: maintaining an assigned numeric values (number indicating the amount of dependencies / number of other plug-ins on which the plug-in depends) in association with software modules (plug-ins), each software module having an assigned numeric value (number that indicates the amount of dependencies / number of other plug-ins on which the plug-in depends) in a relative order; and executing the software modules (plug-ins) in an order determined by each assigned numeric values, the order being deterministic and static (via executing the plug-ins in the order determined based on the amount of dependencies of the plug-in) (col. 13, lines 15-64). It would be obvious to one of ordinary skill in the art that the number of other plug-ins on which the plug-in depends is a static value because each plug-in is associated with a counter stored in memory wherein prior to execution, the counter for each plug-in is loaded with a count that indicates the number of plug-ins on which it depends such that the counter is manipulated to determine when the plug-in is executed (col. 14, lines 4-23) and not the value stored in the file itself. It is also obvious to one of ordinary skill in the art that since there exists a plurality of plug-ins having various numeric values of the plug-ins it depends on (col. 14, lines 43-64; col. 8, lines 48-64; col. 12, lines 50-59), that the order of the plug-ins are two plug-ins having zero dependency and one plug-in have a two dependency such that there exists an unassigned value between assigned values, i.e. zero and two.

As to claim 2, YOUNG teaches executing the software modules comprises calling the software modules (col. 13, lines 15-64; col. 14, lines 4-23).

As to claims 3 and 4, YOUNG teaches the software modules comprise filter drivers (one or more callable procedures or routines) (col. 7, lines 48-55). However, YOUNG does not explicitly state that the functions handled by the software modules or filter drivers are file system requests. Official Notice is taken in that it is well known in the art that plug-ins handle file system requests and that it would be obvious to one of ordinary skill in the art that the plug-ins when execute receive input relating to file processing of input-output packets.

As to claim 5, YOUNG teaches the software modules are attached in a stack (col. 8, lines 38-47).

As to claim 6, YOUNG teaches executing the software modules in an order determined by each of the assigned numeric values includes maintaining an order (col. 13, lines 15-64; col. 14, lines 4-23).

As to claim 7, YOUNG teaches evaluating criteria associated with the software modules, and wherein executing the software modules comprises selecting only software module that meet the criteria for execution (col. 13, lines 15-64; col. 14, lines 4-23).

As to claim 8, refer to claims 3 and 4 for rejection.

As to claim 9, YOUNG teaches assigning an assigned numeric value to a

software module (via determining the number of dependencies of the plug-in which is

stored in a configuration file) (col. 13, lines 15-64; col. 14, lines 4-23).

As to claim 10, YOUNG teaches classifying a software module based on a type

(dependency value) thereof, and wherein the assigned numeric value corresponds to

the type (via executing the plug-ins based on their dependency values) (col. 13, lines

15-64; col. 14, lines 4-23).

As to claims 24 and 25, refer to claim 1 for rejection.

As to claim 21, reference is made to a computer medium that corresponds to the

method of claim 1 and is therefore met by the rejection of claim 1 above. Claim 21

alludes to filter drivers that correspond to software modules in claim 1.

As to claim 22, refer to claims 3 and 5 for rejection.

As to claim 23, refer to claim 2 for rejection.

As to claims 11, 19 and 20, reference is made to a computer system that corresponds to the method of claim 1 and is therefore met by the rejection of claim 1 above.

As to claim 12, refer to claim 5 for rejection.

As to claim 13, refer to claim 3 for rejection.

As to claim 14, refer to claim 4 for rejection.

As to claim 15-18, refer to claim 8 for rejection. However, the cited claims further detail a filter manager orders the filter drivers in a relative order to handle a file request. Therefore, the plug-ins are the filter drivers and are ordered based on the number of dependencies as taught by YOUNG. However, YOUNG does not explicitly state that the functions handled by the software modules or filter drivers are file system requests. Official Notice is taken in that it is well known in the art that plug-ins handle file system requests and that it would be obvious to one of ordinary skill in the art that the plug-ins when execute receive input relating to file processing of input-output packets.
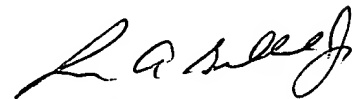
Response to Arguments

5.   Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis A. Bullock, Jr. whose telephone number is (571) 272-3759. The examiner can normally be reached on Monday-Friday, 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LEWIS A. BULLOCK, JR.
PRIMARY EXAMINER

April 14, 2006